

U.S.S.N. 09/891,014

Remarks

Applicants thank the Examiner for kindly extending their attorney, Allison Johnson, and Mr. Crandall the courtesy of a teleconference interview on March 31, 2003, to discuss the pending Office action. No agreement was reached.

Claims 5, 7, 8, 10, 11, and 16-20 have been cancelled without prejudice. Claims 21-35 have been added. Support for new claims 21-35 can be found in general throughout Applicants' Specification and in particular, for example, as follows: claim 21, previous claim 7; claim 22, previous claim 5; claims 23 and 24, original claim 8; claim 25, page 2, lines 23-25; claim 26, page 13, lines 11-22; claim 27, original claim 14; claim 28, original claim 15; claim 29, page 15, lines 1-7; claim 30, original claim 11 and page 8, line 19-page 9, line 11; claim 31, original claim 11; claim 32, page 9, lines 1-10; claim 33, original claim 12 and page 2, lines 23-25; claim 34, page 7, line 14-page 8, line 10 and page 13, lines 11-19; claim 35, page 8, line 19-page 9, line 11.

As a preliminary matter, Applicants seek to correct statements made by the undersigned in the December 12, 2002 Amendment. The statements made by the undersigned in the December 12th Amendment reflect a misunderstanding of the meaning of the term "(meth)acrylamide" as used in the above-captioned application. The term "(meth)acrylamide" as used in the above-captioned application is short hand terminology that is used to refer to both acrylamide and methacrylamide. To the extent that statements made in the December 12th Amendment indicated that the term "(meth)acrylamide" is limited to methacrylamide, those statements were incorrect and are hereby withdrawn.

Applicants submit that the cancellation of claim 5 renders moot the rejection of claim 5 under 35 U.S.C. § 102(b) and § 103 over Coopridier et al. (U.S. 5,571,617).

Applicants submit that the cancellation of claims 8, 10 and 16 renders moot the rejection of claims 8, 10 and 16 under 35 U.S.C. § 103 over Coopridier et al. (U.S. 5,571,617).

Claim 7, now claim 21, stands rejected under 35 U.S.C. § 103 over Coopridier et al. (U.S. 5,571,617).

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Cooprider et al. disclose a coated sheet that includes a backing and a coating of repositionable pressure-sensitive adhesive disposed on the backing. The repositionable adhesive includes solid microspheres, polymeric stabilizer and surfactant.

Claim 21 is directed to an adhesive coated article that includes a microsphere adhesive that includes a chain transfer agent in an amount sufficient to produce 30-98 % of a solvent soluble portion in the microspheres. To establish a prima facie case of obviousness based upon a based on a single prior art reference, there must be a showing of a teaching, suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996); M.P.E.P. 2142. The suggestion or motivation to modify the reference must be found in the prior art and must not be based on Applicants' disclosure. See M.P.E.P. 2142. Here there is no such teaching, suggestion, or motivation. It is undisputed that Cooprider et al. do not teach a microsphere adhesive composition that includes a chain transfer agent. Cooprider et al. also fail to suggest such an adhesive composition. Cooprider et al. generally disclose that optional adjuvants can be included in their composition. However, a chain transfer agent is not included in Cooprider et al.'s list of adjuvants, and nothing in Cooprider et al. teaches or suggests that a chain transfer agent is an adjuvant. Moreover, nothing in Cooprider et al. directs the skilled artisan to include a chain transfer agent in a microsphere adhesive composition. Therefore, Cooprider et al. fail to provide the skilled artisan with the requisite suggestion or motivation for modifying the microsphere adhesive of Cooprider et al. in the manner proposed in the Office action.

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The Office action refers to Japanese Patent Abstract 54003136A and the Concise Encyclopedia of Polymer Science and Engineering to support the rejection of claim 7, now claim 21, under 35 U.S.C. § 103. Nothing in either of these references teaches or suggests modifying the microsphere adhesive of Cooprider et al. to include a chain transfer agent, or including a chain transfer agent during preparation of the microspheres of Cooprider et al. The fact that Japanese Patent Abstract 54003136A mentions that the oligomers disclosed therein can be produced by copolymerizing monomers optionally in the presence of a chain transfer agent provides no teaching, suggestion or motivation to use a chain transfer agent when forming the microspheres of Cooprider et al. Likewise,

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the fact that the Concise Encyclopedia of Polymer Science discloses that chain transfer agents are used to regulate and limit the molecular weight in polymer reactions is of no moment. Nothing in the Concise Encyclopedia of Polymer Science and Engineering teaches or suggests that it would be desirable to limit or regulate the molecular weight of the polymer of the microspheres of Coopridier et al. Accordingly, neither the Japanese Abstract nor the Encyclopedia provides the skilled artisan with any reason to modify the microspheres of Coopridier et al. Applicants submit that a prima facie case of obviousness has not been established. Therefore, the rejection of claim 21 under 35 U.S.C. § 103 over Coopridier et al. cannot stand and must be withdrawn.

Applicants submit that the cancellation of claims 11 and 17-19 renders moot the rejection of claims 11 and 17-19 under 35 U.S.C. § 103 over Delgado (U.S. Patent 4,988,567).

Claim 20, now claim 33, stands rejected under 35 U.S.C. § 103 over Delgado (U.S. Patent 4,988,567).

Delgado discloses a pressure-sensitive adhesive that includes hollow, polymeric, acrylate, inherently tacky, infusible, solvent-insoluble, solvent-dispersible, elastomeric, nitrogen-containing, acid-free microspheres that include at least about 70 parts by weight of at least one alkyl acrylate or alkyl methacrylate ester, and up to about 30 parts by weight of at least one nitrogen-containing polar monomer. A majority of the microspheres has multiple interior voids.

Claim 33 is directed to an adhesive coated article that includes a microsphere adhesive that includes a plurality of microspheres and a polyacrylamide. In other words, there are microspheres present in the adhesive composition as well as polyacrylamide. Delgado does not teach a microsphere adhesive that includes a plurality of microspheres and polyacrylamide. Instead, Delgado discloses microspheres that are prepared from various monomers including alkyl acrylate or alkyl methacrylate ester monomers and nitrogen-containing polar monomers. Thus, to the extent Delgado discloses acrylamide, the acrylamide forms part of the microsphere polymer matrix; it is not a separate component in the microsphere adhesive. Because Delgado fails to teach a required element of claim 33, a prima facie case of obviousness has not been established.

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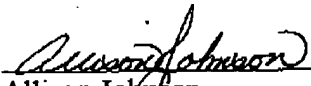
Applicants submit, therefore, that the rejection of claim 33 under 35 U.S.C. § 103 over Delgado cannot stand and request that it be withdrawn.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. The Examiner is invited to telephone the undersigned if a teleconference interview would facilitate prosecution of the above-captioned application.

Please charge any additional fees owing or credit any overpayment made to Deposit Account No. 501,171.

Respectfully submitted,

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